

rejected claims 1-41 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicant regards as the invention;

rejected claim 1 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 2,736,558 (hereinafter referred to as "Ruderman");

rejected claims 1-4 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 3,854,879 ("Candor") in view of U.S. Patent No. 2,535,474 ("Zerpa");

rejected claims 5-11 and 15 under 35 U.S.C. §103(a) as being unpatentable over Candor and Zerpa in view of U.S. Patent No. 2,889,149 ("Williams");

rejected claim 12 under 35 U.S.C. §103(a) as being unpatentable over Candor and Zerpa and Williams and further in view of U.S. Patent No. 4,025,074 ("Hodges");

rejected claims 13 and 14 under 35 U.S.C. §103(a) as being unpatentable over Candor and Zerpa and Williams and further in view of U.S. Patent No. 4,202,543 ("Collins");

rejected claims 16, 17, and 19 under 35 U.S.C. §103(a) as being unpatentable over Candor and Zerpa and further in view of U.S. Patent No. 6,070,879 ("Kemp");

rejected claims 18, 20, and 21 under 35 U.S.C. §103(a) as being unpatentable over Candor and Zerpa and Kemp and further in view of U.S. Patent No. 3,675,922 ("Nieland");

rejected claim 22 under 35 U.S.C. §103(a) as being unpatentable over Candor and Zerpa and Kemp and further in view of U.S. Patent No. 1,661,292 ("Klaus");

rejected claims 23-31 under 35 U.S.C. §103(a) as being unpatentable over Candor and Zerpa in view of Williams, Hodges, and Collins;

rejected claims 32-39 under 35 U.S.C. §103(a) as being unpatentable over Candor, and Zerpa in view of Kemp, Nieland, and Klaus; and

rejected claims 40 and 41 under 35 U.S.C. §103(a) as being unpatentable over Candor, Zerpa, Kemp, Nieland, and Klaus and further in view of U.S. Patent No. D321,736 ("Franklin").

With regard to the Examiner's objection to the drawings for failing to comply with 37 CFR §1.84(e) and (m), corrected drawings are submitted herewith which are believed to remedy the various informalities identified by the Examiner.

With regard to the Examiner's first objection to the drawings for failing to comply with 37 CFR §1.84(p)(5), *closed bottle* 25 (appearing on page 6 of the description) has been added to FIG. 8; *upper leg* 50 (page 6) appears in FIG. 2 as originally filed; *game* 10 (page 8) should be game 20 and the description has been amended accordingly; and *game* 20 (page 9) appears in FIG. 1 as originally filed.

With regard to the Examiner's second objection to the drawings for failing to comply with 37 CFR §1.84(p)(5), reference numeral 48 (appearing in FIG. 2) corresponds to the *clip slot* and appears in the description as originally filed on page 7, lines 7-8; reference numeral 55 (appearing in FIG. 6) corresponds to *lower spring leg* and appears in the description as originally filed on page 6, line 12; reference numeral 97 (appearing in FIG. 11) corresponds to a *clip* and appears in the description as originally filed on page 9, lines 11-12; reference numeral 229 (appearing in FIG. 14) corresponds to a *retaining clip* and appears in the description as originally filed on page 15, line 11; reference numeral 259 (appearing in FIG. 14) corresponds to structure that is identical to the *substantially hollow cylindrical structure* 59, wherein the prefix 2 was included to indicate that the *structure* 59 is being shown in the football embodiment of the game, FIG. 14 has been corrected by removing the reference numeral; and reference numeral 261 (appearing in FIG. 14) corresponds to structure that is identical to the *bottle cap portion* 61, wherein the prefix 2 was included to indicate that the *cap portion* 61 is being shown in the football embodiment of the game, FIG. 14 has been corrected by removing the reference numeral.

With regard to the Examiner's rejections of claims 1-41 under 35 U.S.C. §112, second paragraph, the Applicant responds as follows. Claim 1 includes the elements of "a scoring structure operable to accommodate a ball" and "a mechanism for removably

50  
is  
Spring  
leg

coupling the scoring structure with a bottle". The Examiner asserts that "a ball" and "a bottle" are not positively recited, making it unclear whether the scoring structure is being claimed alone or in combination with ball and a bottle. The Applicant asserts that the ball and bottle are not being claimed in claim 1. The Applicant knows of no clearer way to draft claim 1 without removing all references to functional relationships with unclaimed objects (i.e., the ball and bottle). Claims 23 and 32 were rejected for substantially the same reason as claim 1, and the Applicant responds with the same answer.

Claims 2-4 recite the limitations of "an open", "a closed bottle", and "the bottle", and the Examiner asserts insufficient antecedent basis for these limitations in the claims. Claims 2-4 depend from claim 1 wherein "a bottle" is introduced, thereby providing antecedent basis for later references to "the bottle". "An open bottle" and "a closed bottle" properly introduce these limitations such that no antecedent basis is required. The Applicant believes the claims to be proper, and is confused by the Examiner's rejections. It should also be noted that, as a matter of claim construction, defining the bottle as an open or closed bottle does not make the bottle a positively recited element of the claim, but rather further defines the nature of the "mechanism for removably coupling" as being specifically adapted in an appropriate manner for coupling therewith. Claims 24-26 and 33-35 were rejected for substantially the same reason as claims 2-4, and the Applicant responds with the same answer.

Claim 15 recites "the ball", and the Examiner asserts insufficient antecedent basis for this limitation in the claim. Claim 15 depends from claim 7 which depends from claim 1. As mentioned, claim 1 recites the limitation of "a ball" which provides antecedent basis for later references to "the ball". The Applicant again believes that the claim is properly drafted, and is confused by the Examiner's rejection, particularly given that claim 7, from which claim 15 depends, references "the ball" but was not rejected.

With regard to the Examiner's rejection of claim 1 under 35 U.S.C. §102(b) as being anticipated by Ruderman, the Applicant responds as follows. The Examiner asserts that "Ruderman discloses a game that substantially mimics an aspect of a sport, the game comprising: a scoring structure (57) operable to accommodate a ball in a manner substantially mimicking a scoring aspect of the sport; and a mechanism for removably

coupling (20) the scoring structure (57) with a bottle (21-25) to thereby position the scoring structure for playing". The Applicant respectfully disagrees with the Examiner's interpretation of what is disclosed by Ruderman. Ruderman involves throwing a ball at simulated bottles of milk, and relates itself to "novel amusement devices". The Applicant can identify no sport substantially mimicked by this activity. Ruderman does mention using a baseball as the ball, but this alone is an insufficient basis on which to assert that the game substantially mimics the sport of baseball. Furthermore, that which the Examiner characterizes as a "scoring structure (57)" is, in fact, merely a counter. Ruderman, col. 3, lines 1-2. The counter is a means of keeping score, not a scoring structure as that term is used in the specification of the present application. The counter certainly does not "accommodate a ball in a manner substantially mimicking a scoring aspect of the sport". By way of analogy, in the sport of football the goal posts are scoring structures that accommodate a ball, but the scoreboard on which the score is displayed is not. Thus, no person with ordinary skill in the art or sport would characterize the counter as a scoring structure. Additionally, that which the Examiner characterizes as "a mechanism for removably coupling (20) the scoring structure (57) with a bottle (21-25)" is, in fact, a shaft for "rotatably supporting a plurality of targets 21-25" so as to allow hit targets to rotate rearwardly. Ruderman col. 2, lines 10-11 and col. 3, lines 22-33. The shaft 20 does not "couple" or even extend between the bottles and the counter; instead, the counter is operated by an actuating finger 60 keyed to a different shaft 40. Ruderman, col. 3, lines 3-4. Thus, Ruderman does not disclose that which the Examiner asserts it discloses and does not disclose the present invention as claimed in claim 1.

With regard to the Examiner's rejections of claims 1-4 under 35 U.S.C. §103(a) as being unpatentable over Candor in view of U.S. Patent No. 2,535,474 Zerpa, the Applicant responds as follows. The Applicant respectfully disagrees with the Examiner's interpretation of what is disclosed by Candor. The Examiner asserts that the scoring structure and the coupling mechanism are both met by a tubular member (22) disposed so that a ball (B) can be hit off of the tubular member (22) using a ball bat. Candor col. 3, lines 21-32. The tubular member is obviously not a scoring structure, and certainly not a scoring structure as that term is used in the specification of the present application. The

tubular member certainly does not "accommodate a ball in a manner substantially mimicking a scoring aspect of the sport", but, instead, merely supports and facilitates striking the ball. No person with ordinary skill in the art or sport would characterize the tubular member as a scoring structure.

The Examiner has attempted to combine Candor and Zerpa to reject claims 2-4 toward using different types of bottles. If Candor discloses that which the Examiner asserts, then Zerpa is unnecessary, in which case claim 1 should have been rejected under 35 U.S.C. §102. This, however, would be cumulative and therefore inappropriate in light of the rejection of claim 1 over Ruderman. Thus, the Applicant believes the Examiner's rejection of claim 1 under 35 U.S.C. 103(a) over Candor in light of Zerpa to be inappropriate. With regard to claims 2-4, the Applicant notes that Zerpa discloses no scoring structure operable to accommodate a ball in a manner substantially mimicking a scoring aspect of a sport. Instead Zerpa involves a portable chance device having nothing to do with sports, making Zerpa non-analogous art with regard both to the present invention and to Candor, such that any rejection based on Zerpa is inappropriate. Furthermore, no motivation or suggestion is identified for combining Candor and Zerpa, and none is possible given Zerpa's status as non-analogous art, meaning the Examiner has failed to establish the required *prima facie* case of obviousness in support of the 35 U.S.C. 103(a) rejection, making it inappropriate.

With regard to determining analoguousness, *In re Clay* sets forth a two part test for determining whether a prior art reference is properly analogous with respect to an invention:

"Two criteria have evolved for determining whether prior art is analogous: (1) whether the art is from the same field of endeavor, regardless of the problem addressed, and (2) if the reference is not within the same field of the inventor's endeavor, whether the reference still is reasonably pertinent to the particular problem with which the inventor is involved." *In re Clay*, 23 USPQ2d 1058, 1060 (Fed. Cir. 1992).

An invention cannot be considered to be within the field of endeavor of a prior art reference merely because both relate to the same industry. *Id.* 1060. However, "[a] reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to the inventor's attention in considering his problem". *Id.* 1061. The test set forth in *In re Clay* is applied, for example, in *Wang Laboratories, Inc. v. Toshiba Corp.*, which is cited by and discussed in MPEP §2141.01(a). A review of *Wang* and other applicable cases reveals that analogousness is applied very narrowly, with seemingly very close and relevant prior art references being held non-analogous to the inventions at issue. A rejection based on non-analogous art cannot, of course, be sustained. In the present case, Zerpa is non-analogous as it is neither within the same field of endeavor as either the present invention or Candor, nor is it reasonably pertinent to the problems addressed by either the present invention or Candor.

All other rejections asserted by the Examiner rely on combining Candor, Zerpa, and one or more other prior art references, and are therefore all inappropriate in light of the preceding discussion. However, in order to provide further clarification of the Applicant's position, the Applicant continues hereafter to respond to certain specifics of the Examiner's remaining rejections.

With regard to the Examiner's rejections of claims 5-11 and 15 under 35 U.S.C. §103(a) as being unpatentable over Candor and Zerpa in view of Williams, ignoring the impropriety of combining Zerpa with either Candor or Williams, the Examiner identifies no reasonable motivation or suggestion in any of the references or within the knowledge of one with ordinary skill in the art for combining Williams with Candor, and has therefore failed to establish the requisite *prima facie* case of obviousness. The Examiner has further failed to identify a reasonable suggestion in any of the references or within the knowledge of one with ordinary skill in the art for the desirability of the proposed combination. Thus, the Applicant respectfully asserts that the Examiner's conclusory statement that such combination would have been obvious is, without more, insufficient, and would not be upheld on appeal.

With regard to the examiner's rejections of claims 16, 17, and 19 under 35 U.S.C. §103(a) as being unpatentable over Candor and Zerpa and further in view of Kemp, the Applicant repeats all preceding assertions, as appropriate, and further asserts that Collins is non-analogous art to all of the cited prior art references and the present invention. The mere fact that Collins discloses a game does not make it analogous art to all games.

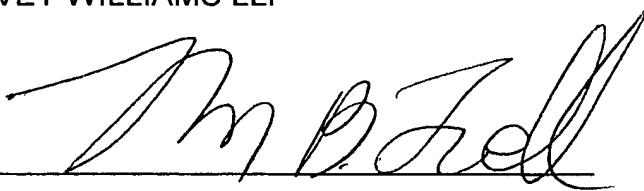
The Applicant also notes that the Examiner has, in many of the rejections, relied on an exceedingly large number of prior art references to meet all of the claimed features. Claims 40 and 41, for example, are rejected over the combination of six different references, Candor, Zerpa, Kemp, Nieland, Klaus, and Franklin. While the Applicant can cite no express prohibition against combining large numbers of references, the Applicant believes that it is an indication that the Examiner has failed to consider the invention as a whole. "In the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious." MPEP §2141.02. Relying on a different reference, as the Examiner has, to reject each separate feature of a claim runs contrary to considering the invention as a whole. Even if the references were analogous and it could be said that they were properly and validly combined and the requisite *prima facie* case of obviousness had been made, the question remains as to whether the invention as a whole, which is more than the mere sum of its features, has been properly considered. The mere fact that the various features of the present invention can be found over a number of disparate references and that a motivation, however thin and unreasonable, can be conceived of for combining one with another does not make the present invention as a whole obvious in light thereof. If such a rejection were allowed, then any and every claimed invention could be easily rejected by merely reducing it to such a degree that all of its constituent components and features could be found among the over six million issued patents. Thus, the Applicant respectfully asserts that the Examiner has treated the claimed features individually and without regard for the invention as a whole, thereby further invalidating the Examiner's 35 U.S.C. §103(a) rejections.

In light of the foregoing, the Applicant believes that no changes to the claims are currently warranted or necessary. The Applicant further believes that all currently pending

claims, claims 1-41, are in condition for allowance, and respectfully requests a corresponding Notice of Allowance. In the event of questions, the Examiner is urged to call the undersigned at 1-800-445-3460. Any additional fee which might be due in connection with this application should be applied against Deposit Account No. 19-0522.

Respectfully Submitted,

HOVEY WILLIAMS LLP

By 

Thomas B. Luebbering, Reg. No. 37,874  
2405 Grand Boulevard - Suite 400  
Kansas City, Missouri 64108  
(816) 474-9050

(Docket No. 31660)